



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

cl

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/845,898

04/30/2001

Ronald J. Kolata

102863-2

4070

21125

7590

07/02/2004

NUTTER MCCLENNEN & FISH LLP
WORLD TRADE CENTER WEST
155 SEAPORT BOULEVARD
BOSTON, MA 02210-2604

EXAMINER

RAMANA, ANURADHA

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 07/02/2004

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,898

Applicant(s)

KOLATA ET AL.

Examiner

Anu Ramana

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 37 is/are rejected.
- 7) ☒ Claim(s) 7-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 16, 2004 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taber (US 406,546 or '546) in view of Camp (US 5,119,585 or '585 herein).

'546 discloses an instrument with a body C, a tissue grasping element F appended to the body with first and second opposed tissue penetrating claws B movable between an open and closed position and an actuating member H mated to the body, effective to move the tissue grasping element between open and closed positions (Figs. 1, 2, col. 1, lines 19-50 and col. 2, lines 70-100).

'546 does not disclose a flexible member secured to body C.

'585 teaches a flexible member or band 94 attached to a hand tool to prevent accidental dropping of the tool when in use by allowing the tool to hang from the wrist of the user (Fig. 1 and col. 4, lines 35-42).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a flexible member, as taught by '585, on body C of '546 to keep the tool attached to the hand of the user to prevent accidental dropping of the tool.

Art Unit: 3732

The method steps of claim 37 are performed during use of the device of the combination of '546 and '585 for the purpose of gripping tissue or an organ.

Claims 1, 3-6 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaslavsky et al. (US 6,228,023 or '023 herein) in view of view of Camp (US 5,119,585 or '585 herein).

'023 discloses an instrument with a body 84, a tissue grasping element 90 appended to the body with first and second opposed tissue penetrating claws 92, 94 movable between an open and closed position and an actuating member 96, 86 mated to the body, effective to move the tissue grasping element between open and closed positions (Fig. 3, col. 7, lines 4-67 and col. 8, lines 1-44).

'023 does not disclose a flexible member secured to body 84.

'585 teaches a flexible member or band 94 attached to a hand tool to prevent accidental dropping of the tool when in use by allowing the tool to hang from the wrist of the user (Fig. 1 and col. 4, lines 35-42).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a flexible member, as taught by '585, on body 84 of '023 to keep body 84 attached to the wrist of a user to prevent accidental dropping of body 84.

The method steps of claim 37 are performed during normal operation of the device of the combination of '023 and '585 for the purpose of gripping tissue or an organ.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-6 and 37 submitted under "REMARKS" in the response filed on April 16, 2004 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3732

Allowable Subject Matter

Claims 7-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anuradha Ramana*
June 28, 2004


EDUARDO C. ROBERT
PRIMARY EXAMINER